

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
Certificate of Transmission under 37 CFR 1.8 I hereby certify that this correspondence is being _____ facsimile transmitted or <u>X</u> e-filed to the United States Patent and Trademark Office - Mail Stop AF. on <u>March 1, 2007</u> Signature <u>Dora Hudgins</u> Typed or printed name: Dora Hudgins		Application Number 10/721196 First Named Inventor MARTIN, HAROLD MACK Art Unit 2121 Filed 11/25/2003 Examiner Michael B. Holmes
<p>Applicant(s) request review of the final rejection in the above identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number: 47,093</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		

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REMARKS**STATUS**

In a Final Office Action mailed on February 15, 2007, the Examiner rejected claims 1-30 under 35 U.S.C. § 101 as being non-statutory subject matter.

CLEAR ERROR IN THE REJECTION OF CLAIMS 1-30 UNDER 35 U.S.C. § 101

Applicants respectfully submit that there is “clear error” in the Examiner’s rejection of claims 1-30 under 35 U.S.C. § 101 because the Examiner has failed to establish a prima facie case of unpatentability. The Examiner bears the initial burden of presenting a case of unpatentability under 35 U.S.C. § 101. (*See* M.P.E.P. § 2106(IV)(D)). Applicants understand that the Examiner is denying the patentability of claims 1-30, since they do not produce “real world ‘tangible’ result.” And, the Examiner is not denying the patentability of these claims based on a lack of a useful or a concrete result.

According to the Examiner, claims 1-30 are non-statutory because they fail to provide a practical application that would produce “a real world ‘tangible’ result.” As an initial matter, Applicants respectfully submit that the MPEP and established case-law merely require a tangible result and not a “real world tangible result,” as suggested by the Examiner. Specifically, a claimed invention is directed to a practical application if it produces a useful, concrete, and tangible result. (*See* M.P.E.P. § 2106(IV)(B)(2)(C)(2); *see also State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093 (1999)). A result is considered a tangible result, if it is a non-abstract result. (*See* M.P.E.P. § 2106(IV)(B)(2)(C)(2)(b); *see also AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999)).

Before providing specific reasoning as to why the pending claims are statutory, Applicants respectfully submit that the Examiner is relying on case-law whose effect has been significantly blunted by subsequent Federal Circuit decisions. For example, the Examiner relies on *In re Sarkar* in making his rejection. That case’s holding, however, was seriously put in doubt when the Federal Circuit in *AT&T*, found the reasoning of *In re Grams*

“unhelpful,” a case in which the Court had relied on *In re Sarkar* type of reasoning. (See 172 F.3d at 1360). In particular, the Court in *AT&T*, noted that *In re Grams* was “unhelpful because the panel in that case did not ascertain if the end result of the claimed process was useful, concrete, and tangible.” *Id.* *In re Sarkar* suffers from the same problem. In other words, the Court in *In re Sarkar* did not ascertain if the end result of the claimed process was useful, concrete, and tangible. Thus, its application in view of recent case-law is dubious at best.

Turning now to the specifics of pending claims, Applicants respectfully submit that claims 1-30 do produce a tangible result. Taking claim 1 as being exemplary, claim 1 requires “when the first pattern match is detected, *selectively accepting the message based on the corresponding pattern match acceptance indicator.*” (emphasis added). Selectively accepting the message based on an indicator is a non-abstract result. This is fully consistent with the reasoning of the Federal Circuit in *AT&T*. In *AT&T*, the Court addressed a claim directed to generating a message record, which comprises the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. (*Id.* at 1354).

In analyzing this claim under 35 U.S.C. § 101, the Court noted that “AT&T’s claimed process employs subscribers’ and call recipients’ PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing purposes.” (*Id.* at 1358). The Court further noted that the “PIC indicator represents information about the call recipient’s PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC’s subscribers.” (*Id.*). Thus, the Court in *AT&T* found a process directed to generating a message record patentable under 35 U.S.C. § 101. In sum, Applicants respectfully submit that processing of messages: generation or acceptance is considered a tangible result under current case law.

Like the claims in *AT&T*, claim 1 relates to a process for selectively accepting the message based on a corresponding pattern match acceptance indicator. As explained in the Specification, selectively accepting the message based on the pattern match acceptance indicator, lessens the frequency of occurrence of full address compares, thereby freeing the processor to perform other tasks. (Specification, paragraph 28). Selectively accepting the message is a tangible result, and is not an abstract result. This is consistent with the background section of the Specification, which explains that devices in a network often receive messages which may or may not be intended for them and they have to determine whether to accept the message or not. (Specification, paragraph 4). Since an exact address match is computationally intensive, any pre-processing of messages, for example, selectively accepting the messages can improve the performance of a device used for processing such messages. Thus, because claim 1 is directed to a process which produces a tangible result, Applicants respectfully request the panel to withdraw the rejection of claim 1.

Claims 2-24 depend, directly or indirectly, upon claim 1 and thus are directed to statutory subject matter for at least the reasons given above with respect to claim 1.

Claim 25 requires a control logic, which selectively accepts the received message when the first pattern match is detected, thus claim 25 is also directed to statutory subject matter at least for similar reasons as given above with respect to claim 1.

Claims 26-30 depend, directly or indirectly, upon claim 25 and thus are directed to statutory subject matter for at least the reasons given above with respect to claim 25.

In conclusion, for all of the reasons given above, Applicants respectfully request the panel to withdraw the rejection of claims 1-30 under 35 U.S.C. § 101.